

Rabbani et al.

Serial No.: 08/978,632

Filed: November 25, 1997

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- June 19, 2001]

REMARKS

In this Request for Continued Examination (RCE), Applicants are filing new claims 246-270. As defined in these new claims and in claim 246 in particular, Applicants' invention is directed to a non-naturally occurring non-native polynucleotide construct comprising at least one sequence segment, which construct when present in a cell produces a product. The construct comprises at least one member selected from the group consisting of a modified nucleotide, a nucleotide analog, a non-nucleic acid entity, and a combination of the foregoing. The product being selected from the group consisting of antisense RNA, antisense DNA, sense RNA, ribozymes, decoys, messenger RNA, protein and a combination of any of the foregoing.

It is believed that these new claims are patentable over the prior art cited of record in this application. More specifically, Meyer et al., U.S. Patent No. 5,574,142 discloses small oligonucleotides intended to act as therapeutic oligonucleotides which are capable of selectively binding to a target sequence of DNA, RNA or protein inside a target cells. In contrast to Applicants' invention as set forth in the new claims herein, Meyer's disclosed oligonucleotide do not produce any products in and of themselves. Instead, their disclosed oligonucleotide brings about change only through a binding capability. See, for example, column 3, lines 53-57 in Meyer et al., U.S. Patent No. 5,574,142. In the February 3, 1999 Office Action, Meyer et al. was characterized as producing an antisense oligonucleotide. Unlike Applicants' claimed invention, Meyer's antisense oligonucleotide is not produced in a cell; rather, it is synthesized *in vitro* (outside of

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a cell) and later introduced into a cell. Accordingly, Meyer et al. is deficient in at least one material element of Applicants' claimed invention, i.e., a product produced in a cell, such product being selected from the group consisting of antisense RNA, antisense DNA, sense RNA, ribozymes, decoys, mRNA, protein and combinations thereof.

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SUMMARY AND CONCLUSIONS

Claims 246-270 are presented for further examination in this RCE.

An extension request and fee are set forth in the accompanying RCE Transmittal.

If a telephone conversation would further the prosecution of the present application, Applicants' undersigned attorney request that he be contacted at the number provided below.

Respectfully submitted,



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